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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,441	04/05/2001	Peter Fall	VCC0031-US	4762

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 11/06/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.
09/681,441

Applicant(s)
FALL

Examiner
Luong

Art Unit
3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/15/02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/5/01 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Exhibit

Vinh T. Luong
Primary Examiner

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1. The restriction requirement on August 21, 2002 has been withdrawn in view of applicant's explicit admission that the two embodiments illustrated in the Figures are not patentably distinct in the Reply under 37 CFR 1.111 filed on October 15, 2002 (Paper No. 10).
2. The listing of references in the specification (page 1) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
3. The information disclosure statement filed April 5, 2001 which is incorporated into the specification (page 1) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
4. The drawings are objected to because each part of the invention, such as, the vehicle cab in claim 1, the carrying vehicle in claims 7 and 8, and the telescoping member in claims 11-13 should be designated by a referential numeral or character. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as the vehicle cab in

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claim 1, the carrying vehicle in claims 7 and 8, and the telescoping member in claims 11-13 must be shown or the features canceled from the claims. No new matter should be entered.

6. The disclosure is objected to because of the following informalities: each part of the invention, such as, the vehicle cab in claim 1, the carrying vehicle in claims 7 and 8, and the telescoping member in claims 11-13 should be designated by a referential numeral or character. Appropriate correction is required.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as, "an operating device" and "an element" in claim 1. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

8. Claims 1-6 and 9-17 are objected to because of the following informalities:

(A) the claims should not contain the underlining (e.g., claim 1) because the underlining is used to indicate the addition in amendment only. See 37 CFR 1.121; and

(B) the claims contain typographical errors. For example, "paced" in line 4 of claim 1 should have been "spaced" and "C claim" in claims 4-6, etc. should have been "claim."

Appropriate correction is required.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 11-13 call for a telescoping member. However, the drawings do not show the telescoping member. It is unclear as to how applicant makes/uses the claimed telescoping member and connected it to claimed pedal arrangement.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

No antecedent basis is seen for the terms, e.g., "foot plate" in line 5 of claim 1 and "the telescoping member" in claims 12 and 13.

It is unclear:

(A) whether a confusing variety of terms, such as, "a vehicle" and "a carrying vehicle" in claims 7 and 8 refer to the same or different things. See MPEP 608.01(o) and 2173.05(o). Applicant is respectfully urged to identify each claimed element with reference to the drawings; and

(B) which structure(s) define(s) the claimed element, such as, "an element" in claim 1. Applicant is respectfully urged to identify each claimed element with reference to the drawings.

The terms, such as, "*substantially*" in claim 1 and "*rigidly*" in claims 4 and 5 are relative terms which render the claims indefinite. The terms "*substantially*" and "*rigidly*" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one

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of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear, *e.g.*, in claim 1, what range of the changes of the distance between the attachment points to the respective arm is considered to be “*substantially* constant.”

The terms, such as, “connectable” in claim 7 and “bendable” in claim 10 are vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, the motion-transmitting element is connectable, but is not required structurally to be connected between the pedal arm and the pedal actuated operating device. See “crimpable” and “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5, 7-12, 14, 16, and 17, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by Bayer (German OS No. 31 40329 A1 cited by applicant).

Regarding claim 1, Bayer teaches a pedal arrangement in a vehicle cab, said arrangement comprising:

a support 26 fixed in the cab;

at least one pedal arm 22 journaled in the support 26 for pivoting about a pivot axis

24 spaced from the two ends of the pedal arm 22;

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a foot plate (unnumbered) fixed to a portion of the pedal arm 22 on one side of the pivot axis 24;

motion-transmitting element 10, 12 that is joined firstly to the portion of the pedal arm 22 on the other side of the pivot axis 24 from the foot plate and secondly to a pivotally mounted lever 4 that is configured so that pivotation thereof actuates an operating device 2 fixed to an element 6, 80, 82 spaced from the support 26;

the motion-transmitting element 10, 12 is disposed so that the distance between its attachment points to the respective arms 22 is inherently maintained at least substantially constant when there is a tensile force on the element 6, 80, 82 and is allowed to be shortened when there is compressive force on the element 6, 80, 82.

Claim 1 and other claims below are anticipated by Bayer. On the one hand, Bayer teaches each claimed element and its intended use. On the other hand, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, the motion-transmitting element is an elongated flexible element 10.

Regarding claim 3, the motion-transmitting element is a metal cable 10.

Regarding claim 4, the motion-transmitting element 10 is rigidly fixed to at least one of the pedal arm 22 and the lever 4, and is pivotally joined to the other of the two arms 18 and 22 (Fig. 1).

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Regarding claim 5, the motion-transmitting element 10 is *rigidly* fixed both to the pedal arm 22 and to the lever 4.

Regarding claim 7, Bayer teaches a pedal arrangement for a vehicle, said arrangement comprising:

a pedal arm 22 arranged to be pivotally connected to a carrying vehicle at a pivot point 24 located on the pedal arm 22, the pivot point 24 being positioned between an upper end 18 and a lower end 22 of the pedal arm 22; and

a motion-transmitting element 10, 12 connectable between the pedal arm 22 and a pedal actuated operating device 2, the motion-transmitting element 10, 12 being capable of supporting tensile forces imposed thereupon, and collapsing under compressive forces imposed thereupon.

Claim 7 is anticipated by Bayer. On the one hand, Bayer teaches each claimed element and its intended use. On the other hand It has long been held that the recitation that an element is “adapted to perform” or “capable of performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946). On the other hand, it is well established that: (a) a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and (b) the functional limitations of a claim may not be given patentable weight where those

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limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

Regarding claim 8, Bayer teaches a brake pedal arrangement in a vehicle, said arrangement comprising:

a brake pedal arm 22 pivotally connected to a carrying vehicle at a pivot point 24 located on the brake pedal arm 22, the pivot point 24 being positioned between an upper end 18 and a lower end 22 of the brake pedal arm 22; and

a motion-transmitting element 10, 12 connected between the brake pedal arm 22 and a pedal actuated operating device 2, the motion-transmitting element 10, 12 supporting tensile forces imposed thereupon, and collapsing under compressive forces imposed thereupon.

Regarding claim 9, the motion-transmitting element is a cable 10.

Regarding claim 10, the motion-transmitting element 10 being a bendable member.

Regarding claim 11, the motion-transmitting element 10, 12 is a telescoping member since the cable is slid back and forth within the conduit 12.

Regarding claim 12, the telescoping member 10, 12 is pivotally connected to the brake pedal arm 22.

Regarding claim 14, the motion-transmitting element 10, 12 is fixed at least at one end thereof between the brake pedal arm 22 and the pedal actuated operating device 2.

Regarding claim 16, the motion-transmitting element 10, 12 is pivotally connected at least at one end thereof between the brake pedal arm 22 and the pedal actuated operating device 2.

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Regarding claim 17, the pedal actuated operating device 2 is a pressure actuated servo unit for affecting brake pressure application.

15. Claims 1 and 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Jean'333 (French Application No. 2,555,333).

Regarding claim 1, Jean'333 teaches a pedal arrangement in a vehicle cab, said arrangement comprising:

- a support (i.e., a bracket unnumbered at 12 in Fig. 2, see Exhibit attached) fixed in the cab;

- at least one pedal arm 1 journaled in the support for pivoting about a pivot axis 1a spaced from the two ends of the pedal arm;

- a foot plate (unnumbered) fixed to a portion of the pedal arm 1 on one side of the pivot axis 1a;

- motion-transmitting element 7 that is joined firstly to the portion of the pedal arm 1 on the other side of the pivot axis 1a from the foot plate and secondly to a pivotally mounted lever 2 that is configured so that pivotation thereof actuates an operating device 3 fixed to an element (Exhibit) spaced from the support;

- the motion-transmitting element 7 is disposed so that the distance between its attachment points to the respective arms 1 is inherently maintained at least substantially constant when there is a tensile force on the element and is allowed to be shortened when there is compressive force on the element.

Claim 1 is anticipated by Jean'333. See *In re Casey* and *In re Otto, supra*.

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Regarding claim 6, the lever 2 is joined to a rocker arm 15, 19, which, when the lever 2 is pivoted, acts on an actuator rod (see Exhibit) for a brake servo unit 3, which is located on the outside of an intermediate wall 5 on the inside of which the support is located spaced from the intermediate wall 5.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 13 and 15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer or Jean'333.

Bayer or Jean'333 teaches applicant's embodiment in Fig. 1. Applicant explicitly admits that the two embodiments illustrated in the Figures are not patentably distinct in Paper No. 10.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to weld at least one end of the telescoping member (motion transmitting element) of Bayer or Jean'333 to the brake pedal arm as explicitly admitted by the applicant. See fifth paragraph on page 2 of the restriction on August 21, 2002, *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978), MPEP 803,

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and *Anything You Say Can Be Used Against You*, Lance Leonard Barry, May 2000, JPTOS, Volume 82, No. 5, page 347.

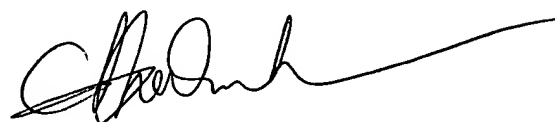
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Jean'070 (Fig. 1), Japanese Utility Model 8-132916 (Figs. 1-7), Japanese Utility Model 2000-238550 (Figs. 1-7), Pirotais (Figs. 1-6), Reno (Fig. 1), De Grazia (Fig. 1), Wolpert (Fig. 2), Forssell et al. (Fig. 1), Watanabe (Figs. 1-30), Prohaska et al. (Fig. 1), and Fisher (Fig. 1).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

October 31, 2002



Vinh T. Luong
Primary Examiner

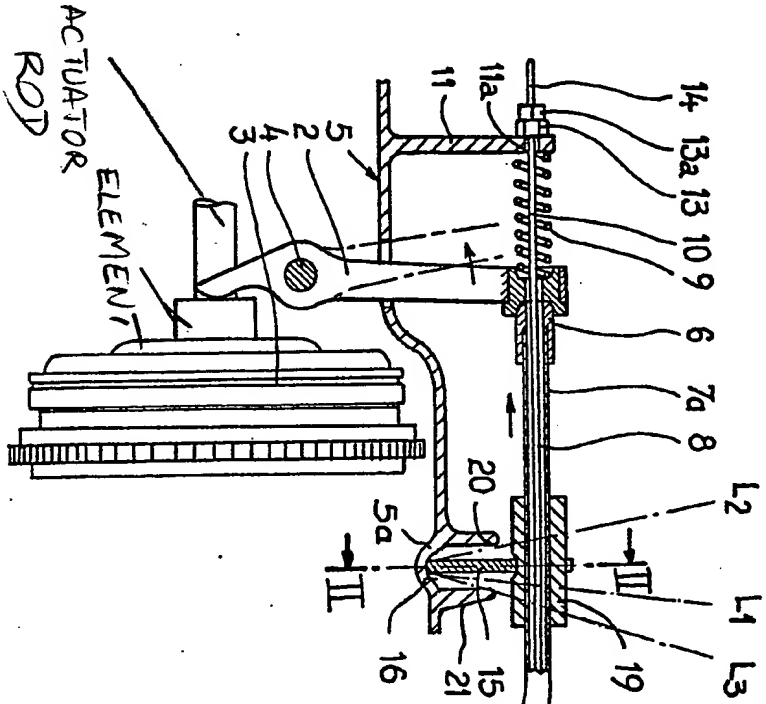


FIG. 1

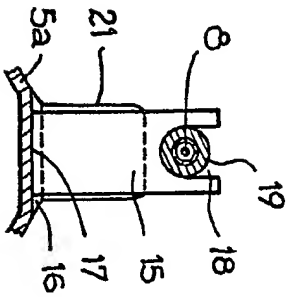


FIG. 2

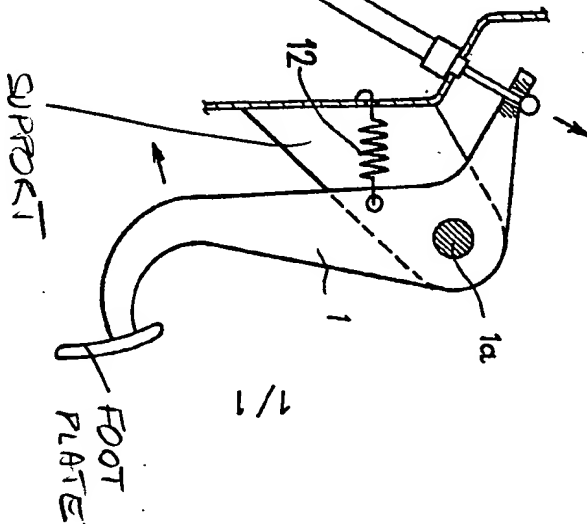


EXHIBIT 11

2555333

PEUGEOT